

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action in which all claims were rejected. Applicants respectfully request reconsideration in view of the following:

THE OBJECTION TO CLAIM 9 AND AMENDMENT TO CLAIM 35

The error noted by the Examiner in claim 9 has been corrected as required. Applicants appreciate the Examiner's noting of this minor error. Claim 35 has also been amended to remove a redundant "and". Reconsideration is respectfully requested.

THE REJECTIONS UNDER 35 U.S.C. §103

Regarding the rejections to all claims, each of which is based at least in part on the combination of Allibhoy in view of Schena of record, Applicant respectfully traverses the rejections and requests reconsideration as follows. Applicant further wishes to note the written request for interview presented below.

Regarding claims 1 and 35, the Office Action asserts that the Schena discloses "registering the product with a plurality of vendors subscribing to a product registration service provided by the television service provider (col. 5, l. 63 - col. 6, l. 4) for the purpose of providing users with user interest information regarding competing products (col. 6, ll. 1-4)." Applicant respectfully disagrees. The cited passage of Schena states in its entirety:

"For example, a person scans an identifying code 10 related to a brand of computer. The computer manufacturer would like to direct the person to its information site. However, the person who performed the scan or portal service 200 that processed the scan, may choose to auction off the instance of the scan to a competitor, thereby allowing the competitor to bid for the right to transmit more information to the person about the competitor's comparable product or a transaction, such as user interest information."

Note that claim 1 requires that the product be registered with a plurality of vendors who subscribe to a product registration service. Schena only teaches or suggests that the instance of a scan can be auctioned off to a competitor. The distinction is clear, and Schena fails to disclose or suggest that which is required by the claim. Applicant notes that

MPEP 2143.03 requires that "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art" *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)." Accordingly, reconsideration and allowance of claims 1-6 and 35-41 are respectfully requested.

Regarding the rejection to claims 7-18, the Office Action asserts that "Schena discloses resubmitting a request for quote to a plurality of vendors (col. 5, l. 63 -c col. 6, ll.1-4)." This is the same passage quoted above. Applicants find no such disclosure in the passage. This passage simply indicates that the person who performed the scan or portal service that processed the scan, may auction off the instance of the scan. Any reading of the claim language onto the actions of Schena is clearly an unreasonably broad interpretation. This is especially true in light of the failure of this passage to relate in any way to response to processing an RFQ originating at the user and associated quotes provided by vendors. Reconsideration and allowance are respectfully requested.

Regarding claims 19-28, among other limitations, these claims clearly require "matching the product registration data to a plurality of vendor registrations submitted by a plurality of vendors". The Office Action asserts that this limitation is met by the disclosure of col. 4, ll. 40-45 and col. 6, ll. 1-10 of Allibhoy. Applicants have reviewed these cited passages and finds no such teaching or suggestion. Allibhoy, in the cited passages, matches a query for a particular product with catalog entries of vendors to find a match. It is noted that in Applicants' claims, a product registration clearly requires that the product has already been purchased, thus catalog queries are in no way analogous. Reconsideration and allowance are respectfully requested.

Regarding the rejection of claims 29-34, upon review of claim 29 it was determined that the claim lacked clarity. Accordingly, claim 29 has been amended to clarify the nature of the registration. In view of this clarification, it is clear that the cited passages between col. 5, l. 63 and col. 6, l. 4 are inapplicable. While the claim is believed to distinguish over the cited art as presented, the claim has been further amended to call out the filtering

function described in connection with Fig. 8 of the specification. In view of these amendments, reconsideration is respectfully requested.

REGARDING THE COMBINATION OF REFERENCES

Applicant further submits that there is no motivation in the art to make the proposed combination of Allibhoy and Schena (as well as the remaining references and Official Notice) as proposed by the Office Action. The Office Action provides only cursory reasoning as to why one of ordinary skill in the art would be motivated to make the proposed combination, for example:

- "for the purpose of providing users with user interest information regarding competing products"
- "for the purpose of generating additional revenue"
- "for the purpose of permitting the customer to disguise their identity"
- "for the purpose of protecting recipients from undesired content"
- "for the purpose of permitting the customer to disguise their identity in a method of obtaining quotes"
- "for the purpose of facilitating user selection of a RFQ"
- "for the purpose of enabling products to be electronically linked with advertisements, product specs, ..."
- "for the purpose of providing a convenient, easy to use interface for performing data entry in a method for registering a product"

Applicants submit that the above generalities, while perhaps verbalizing desirable qualities or attributes of certain embodiments of Applicants' invention, do not meet the requirements for the Examiner to specifically identify what motivation exists in the art for making the proposed combination or modification. One might as well simply state that all combinations of references are motivated by the need for improved inventions and all inventions would be rendered unpatentable.

It is noted that MPEP 2143.01 states in part:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or

implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. 'The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.' *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

The requirement, as laid out in the MPEP, is clearly not met by the generalities expressed in the Office Action. Applicants wish to stress that the above requirement of the MPEP, as called for consistently by the CAFC, is a very real requirement that must be satisfied by the Examiner in order to preclude inventors from entitlement to patent protection for their inventions. In the absence of a clear motivation in the art, the patent statutes demand that the patent be granted. Accordingly, full reconsideration of the lack of motivation to make the proposed combination is respectfully requested.

INTERVIEW REQUEST

The undersigned's experience with applications examined in the present classification suggests that the most expedient way to resolve any outstanding issues is by way of personal or telephonic interview. Further, interviews were encouraged by many of the SPEs present at the most recent Business Methods Partnership Meeting. Accordingly, the undersigned respectfully requests the courtesy of an interview prior to issuing any further action on the merits in this case. Should additional amendments be required in order to expedite allowance of the present application, the undersigned will be happy to consider making such amendments. The undersigned respectfully requests that the Examiner call the undersigned to arrange a mutually convenient time for such an interview.

CONCLUDING REMARKS

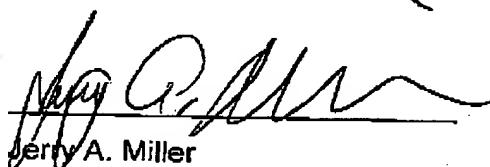
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and amendments, further discussion of these deficiencies is believed to be unnecessary at this time. Failure to address each point, each reference and each instance of Official Notice raised in the Office Action should accordingly not be viewed as accession to the Examiner's position. No amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references.

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. The undersigned further reiterates the request for interview presented above and earnestly solicits a dialog with the Examiner in order to bring this case to a speedy resolution.

Respectfully submitted,



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